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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,328	12/27/1999	ERICH E. KUNHARDT	226333	3830

20694 7590 11/04/2003

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EXAMINER

PATEL, VIP

ART UNIT	PAPER NUMBER
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2879

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/381,328	KUNHARDT ET AL.	
	Examiner	Art Unit	
	Vip Patel	2879	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-28,31-37 and 40-65 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24-28,31-37 and 40-65 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>0703</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tsukada (EP0364215).

Tsukada discloses a plasma discharge apparatus (figures 1-2) comprising a pair of electrodes (4 and 6) having a space there between, a perforated dielectric (23) placed over one of the electrodes, a time varying electric field (7) generated between the two electrodes.

As per claim 25, time varying electric field is generated by AC current (7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26, 33, 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukada.

Tsukada discloses all the limitations of claims 26, 33, and 42-44 except the teaching of a DC current source and specific method steps.

The applicant, in claim 25, have indicated that such device can be operated with AC power source as alternative to DC power source. Tsukada have already disclosed that such device can be operated with AC power source. Therefore, operating of such device with DC power source is matter of design choice. Alternatively, applicant's disclosure fails to show such limitations to solve any problems or to yield any unobvious advantage that is not within the scope of the teachings applied. Therefore, such limitations would be a matter of design alternative.

Regarding claims 33 and 42-44, the combination of references cited and discussed regarding the apparatus of claims 24-26 disclose all of the individual elements of the method of claims 33, 42-44. The artisan seeking to implement the apparatus of claims 24-26 would necessarily perform the method of claims 33, 42-44. Thus, it would have been obvious, at the time the invention was made, to a person having ordinary skill in the art to combine the teachings of the cited references to result in the method as claimed for the reasons given in regarding claims 24-26.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24-28, 31-37, 40-65 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17, 1-26, 1-15 of U.S. Patent Nos. 5872426, 6147452, and 6005349, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other for following reasons.

Claims 24-25 recites additional element of "time varying" electric field in comparison with claim 1 of US Patent No. 5872426. However, claim 11 of US Patent 6147452 recites AC power source which inherently generates time varying electric field.

The limitations of claim 27 is disclosed by claim 2 of US 5872426.

The limitations of claim 28 is disclosed by claim 3 of US 5872426.

The limitations of claim 31 is disclosed by claim 6 of US 5872426.

The limitations of claim 32 is disclosed by claim 7 of US 5872426.

The additional limitations of claim 33 is disclosed by claim 16 of US 5872426.

Similarly all the claimed limitations of instant application are disclosed either by a claim or combination of claims from US patent Nos. 5872426, 6147452, and/or 6005349

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vip Patel whose telephone number is (703) 305-4846. The examiner can normally be reached on Tuesday-Thursday during regular working hours. The fax phone number for this Group is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.


VIP PATEL
PRIMARY EXAMINER
ART UNIT 2879